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Examiner: L. Cruz
Art Unit: 2841

REMARKS

This case has been granted special status and Applicant fully appreciates the diligence of the office in further examination and consideration of the application accordingly. To further that process, Applicant has amended the specification and claims to place the case into better condition for allowability.

Claims 1-13 were the subject of the present Supplemental Office Action. Claim 1 is amended to correct a typographical error. New claims 14-27 are added to more fully describe the invention. More specifically, claim 14 is a claim generic to both groups of claims asserted by the Examiner in her requirement for restriction. Claims 15-27 are added to clarify aspects found in the inventions of claims 1 and 5. It is believed that none of the claim amendments will broaden the Examiner's search field.

The specification has been amended to render the summary of the invention consistent with the amended claims. No new matter is added by any of the amendments.

In the Supplemental Action, the Examiner has required restriction of the application under 35 U.S.C. § 121 to one of two groups of claims. In view of newly added claim 14, the restriction requirement is moot and should be withdrawn.

Applicant respectfully submits that in all claims considered in the Supplemental Action, patentability lies in the specific arrangement of contact points. Accordingly, Applicant has added claim 14, which is generic to both asserted groups. In the event the restriction is made final or a further restriction should be considered appropriate, e.g., a species restriction, Applicant provisionally elects, with traverse, those claims drawn to the integrated circuit package device, identified by the Examiner as Group I, i.e., claims 1-4, 10 and 12 in the Supplemental Action in addition to the newly added claims 14-19 and 25-27.

The Examiner classifies Group I as drawn to a semiconductor device and Group II as drawn to a printed circuit board (PCB), asserting that they are subcombinations disclosed as usable together in a single combination, but having separate utility and, therefore, distinct. However, Applicant respectfully submits that the asserted utilities are not, in fact "separate," and therefore restriction is unwarranted.

The Examiner states that Group I has separate utility as a chip and Group II has separate utility as a circuit board, but the Examiner fails to provide genuine examples of

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separate utility. MPEP §806.05(d). A chip is merely one form of an integrated circuit package device, and not an example of utility apart from the combination. One would be hard pressed to find utility of a chip apart from a PCB. Simply saying that a chip is not a PCB is insufficient to establish "separate utility" as required. Conversely, Group II *is* a circuit board and to say that it has separate utility as a circuit board is circular. Admittedly a circuit board need not always be usable with an integrated circuit package device as claimed in claim 1, for example, but a circuit board made expressly for that purpose (as claimed in claim 5) would undoubtedly find little, if any utility apart from the purpose for which it is made.

In any event, claim 14 is generic to both groups, thereby obviating the basis for restriction. New claims 15-27 are added to define different combinations of the elements in claim 14. Applicant respectfully submits that in all claims, patentability lies in the specific arrangement of contact points. Upon a determination of allowability of the provisionally elected claims, Applicant requests that the non-elected claims be rejoined. Any questions concerning the foregoing or any arrangements for an interview (in accord with special examination practice under MPEP §708.02) may be directed to the undersigned at 616-742-3513 (jeb@mcgarrybair.com) or to G. Thomas Williams of McGarry Bair PC at 616-742-3514 (gtw@mcgarrybair.com).

Respectfully submitted,
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